

## REMARKS

Reconsideration of the present application is requested on the basis of the following particulars.

1. Notice of References Cited

In the outstanding Office Action, it appears that U.S. Patent 6,104,036 (Mazowiesky) is newly cited against the above-application. Upon a review of the Notice of References Cited attached to the Action, U.S. Patent 6,104,036 is not listed on the Notice of References Cited. Applicants respectfully request a corrected Notice of References Cited citing U.S. Patent 6,104,036 in the next communication from the Examiner.

2. Information Disclosure Statement of September 3, 2003

Applicants note that there was no acknowledgment of the Information Disclosure Statement filed on September 3, 2003 in the outstanding Office Action. A copy of the Information Disclosure Statement and receipt card was forwarded to the Examiner on January 22, 2004. Acknowledgment of consideration of the references cited in the Information Disclosure Statement is respectfully requested in the next communication from the Examiner.

3. Rejection of Claims 10-18 under 35 U.S.C. § 112, 1<sup>st</sup> paragraph

Applicants appreciate the courtesy of the Examiner for allowing time to discuss this rejection on April 8, 2004.

Claims 10-18 presently stand rejected on the basis that the term "fitness" used in the claims and the specification adds new matter. It will be noted that the term "fitness" was provided to replace the expression "state of use" originally used in the claims as originally filed. Applicants have acquiesced and decided to revert usage of the term "fitness" to "state of use" in order to expedite the prosecution of the present application.

It is well understood that an Applicant is not limited to the nomenclature used in an application as filed (MPEP 608.01(o)). Moreover, just because the exact term “fitness” was not used in the application does not prohibit the subsequent use thereof in the present application. Instead, 35 U.S.C. 112, 1<sup>st</sup> paragraph prohibits the addition of new subject matter to an application and not new nomenclature to replace an already existing description of subject matter in an application. Applicants submit that the replacement of the expression “state of use” with the term “fitness” did not amount to the addition of new matter.

In the present application, the term “fitness” derives clear support and antecedent basis from the expression “state of use.” Applicants have appended the ordinary dictionary (Merriam-Webster Online Dictionary) meanings of the terms “fitness” and “fit,” wherein “fitness” is defined as “the quality or state of being fit,” and “fit” is defined as “to be suitable for or to.”

In addition, Applicants submit that one of ordinary skill in the art would readily recognize that the expression “state of use” is generally synonymous when referring to sheet material or bank note inspection.

In view of the ordinary dictionary meanings of the terms “fitness” and “fit” fall within the ambit of the expression “state of use.” Accordingly, Applicants submit that the reversion of the claims to recite “state of use” has no limiting effect on the claims.

According to the amendment of claims 10, 14, 16 and 18 withdrawal of this rejection is respectfully requested.

4. Rejection of Claims 10-18 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph

Claims 10-18 presently stand rejected on the basis that the term “fitness” is indefinite and the description of “identical” illumination units in claim 10 appears to contradict their description in claim 11. As described above, claims 10 and 14 have been amended to revert to the originally recited expression “state of use.” Moreover, claim 10 has also been amended by the removal of the term “identical” in reference

to the illumination units to avoid any confusion regarding the description of such illumination elements in claim 11.

In view of the above-described amendments, withdrawal of this rejection is respectfully requested.

5. Amendments to the Claims

As shown in the List of Current Claims, claim 10 has been amended to recite that the plurality of sensors are configured to detect diffusely reflected light. Support for this statement is found in the specification of the present application on page 3, line 3. Moreover, claim 10 has been amended to recite that the illumination units operate “simultaneously” to illuminate both sides of the bank note. Support for this amendment has been taken from claim 11, which has been amended accordingly.

In addition, claim 14 has been amended to recite that the opposed sides of the preselected segment of the bank note is illuminated at the same “brightness” or intensity. Support for this amendment is found in the specification of the present application on page 3, last paragraph.

Acceptance of these claim amendments is respectfully requested in the next communication from the Examiner.

6. Rejection of Claim 10 Under 35 U.S.C. § 102(b) as Being Anticipated by U.S. Patent 5,892,239 (Nagase)

Claim 10 presently stands rejected as being anticipated by the disclosure of Nagase. In view of the following observations and the amendment of claim 10, this rejection is respectfully traversed.

In observing the description provided by Nagase, it is readily apparent that this disclosure relates to an apparatus configured for detection of security threads comprising a resin or metal (col. 2, lines 65-67). As discussed by Nagase, a discriminating apparatus is provided that includes light receiving devices 18 emitted

from irradiating devices and reflected by the surface of a banknote. The light receiving devices are specifically described as separating received light reflected from the security threads into P-polarized light and S-polarized light (col. 4, lines 16-64). Thus, Nagase describes an apparatus wherein controlled polarization is used to detect security threads.

The disclosure of Nagase fails to describe or suggest an apparatus wherein a plurality of sensors are configured to detect diffusely reflected light, as presently recited in claim 10 of the present application. It will be pointed out that it is well understood that diffusely reflected light would not display controlled polarization, as used in the apparatus of Nagase. Thus, the disclosure of Nagase cannot be construed to teach the detection of diffusely reflected light.

Turning to FIG. 7 of Nagase, two sets of irradiating devices 6 and light receiving devices 18 are provided, and such devices are focused to correspond to two different predetermined areas of a bank note. It will be pointed out that in the apparatus of claim 10 of the present application, the sensor units and the illumination units are positioned on opposite sides of the transport path of the apparatus, and the illumination units are positioned and configured to illuminate directly opposed sides of a preselected segment of a bank note.

The configuration of the illumination units and sensor units of the present application is critical in that, as discussed on page 1, last full paragraph in the specification, alignment of the sensor units and the illumination units at a predetermined section avoids misjudgments in areas of the bank note. On the other hand, FIG. 7 of Nagase illustrates a different embodiment wherein this drawing clearly illustrates multiple sections of the bank note which are illuminated and detected at different moments. Moreover, Nagase explains that it is "required to detect light reflected by the four positions of a bill for discriminating the genuineness of the bill based on the presence or absence of a security thread 10, the material thereof and the position thereof" (col. 7, lines 3-7).

Thus, in view of these observations, Applicants submit that the Nagase disclosure fails to teach or suggest each and every element of the claimed invention of claim 10 of the present application. Withdrawal of this rejection is respectfully requested.

7. Rejection of Claim 10 Under 35 U.S.C. § 102(b) as Being Anticipated by U.S. Patent 6,104,036 (Mazowiesky)

Claim 10 presently stands rejected as being anticipated by the disclosure of Mazowiesky. In view of the following observations and the amendment to claim 10, this rejection is respectfully traversed.

In observing the disclosure of Mazowiesky, the method described in connection with FIG. 8, which was used in the rejection in the Action as a teaching against claim 10 of the present application, relates to illuminating a first area of a bank note with a first illuminator 110 positioned on one side of the bank note and receiving reflected light from the first light source with a first sensor 120. Moreover, a second illuminator 110' disposed on an opposite side of the bank note from the first illuminator 110 is activated after the signals are received by the first sensor 120 and reflected light from the second illuminator 110' with a second sensor.

It is clear that the Mazowiesky disclosure fails to disclose or suggest "simultaneous" illumination of opposed sides of a bank note and instead the Mazowiesky disclosure describes alternate or subsequent illumination of the bank note.

Thus, in view of these observations, Applicants submit that the Mazowiesky disclosure fails to teach or suggest each and every element of the claimed invention of claim 10 of the present application. Withdrawal of this rejection is respectfully requested.

8. Rejection of Claims 14, 15 and 18 Under 35 U.S.C. § 103(a) as Being Unpatentable Over U.S. Patent 5,892,239 (Nagase)

Claims 14, 15 and 18 presently stand rejected as being unpatentable over the Nagase disclosure. The shortcomings of the teachings of Nagase have been outlined above. Claim 14 is a method claim which generally parallels the apparatus of claim 10, and it is submitted that the Nagase disclosure fails to disclose or suggest the method of claim 14 for reasons similar to claim 10. Claims 15 and 18 depend from claim 14.

It was acknowledged in the Action that the Nagase disclosure fails to specifically disclose the step of simultaneous illumination directly opposed sides of a preselected segment of a bank note. It is alleged in the Action that while Nagase fails to disclose this critical feature of the present application, it would be obvious to do so in view of the Nagase disclosure. Applicants respectfully disagree with this assessment and request the Examiner to proffer findings based on objective evidence in the Nagase disclosure that would motivate a skilled artisan to arrange the light sources to operate simultaneously to illuminate a preselected segment of a bank note in combination with the other method steps of claim 14.

In summary, Applicants have carefully considered this rejection but it is most respectfully traversed for the reasons discussed above. Accordingly, Applicants respectfully request reconsideration of the rejection and the withdrawal thereof.

9. Rejection of Claims 16 and 17 Under 35 U.S.C. § 103(a) as Being Unpatentable Over U.S. Patent 5,892,239 (Nagase) in View of U.S. Patent 6,040,584 (Liu et al.)

Claims 16 and 17 presently stand rejected in view of the combination of the disclosures of Nagase and Liu et al. Claims 16 and 17 depend from claim 14.

This rejection is respectfully traversed on the basis that the teachings of Liu et al. fail to make up for the basic shortcomings of the Nagase disclosure. More specifically, the Liu et al. disclosure fails to disclose or suggest the detection of diffusely reflected light. Applicants submit that a skilled artisan would not be

motivated by the disclosures of Nagase and Liu et al. to configure illumination units to simultaneously illuminate a preselected segment of a bank note.

Thus, in view of these observations, Applicants submit that the Nagase and Liu et al. disclosures, whether considered collectively or individually, fail to teach or suggest features of claims 16 and 17 of the present application. Withdrawal of this rejection is respectfully requested.

10. Conclusion

In view of the amendments to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that claims 10-18 be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's Attorney, the Examiner is invited to contact the undersigned at the numbers shown below.

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Date: April 14, 2004

amendment 140404.wpd

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin J. Cassell", written in a cursive style.

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